

REMARKS

In the final Office Action mailed July 7, 2010, claims 1 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams et al. (U.S. Patent Publication No. 2004/0008209; hereinafter “Adams”) in view of Deas et al. (U.S. Patent Publication No. 2004/0002904; hereinafter “Deas”). Claims 2 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Deas and further in view of Goff et al. (U.S. Patent Publication No. 2003/0206107; hereinafter “Goff”) and in further view of Fraier et al. (U.S. Patent Publication No. 2003/0001016; hereinafter “Fraier”). Claims 3–5, 7, and 11–14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Deas in further view of Fraier. Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Deas in further view of Goff. Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Deas in further view of Goff and in further view of Fraier and in further view of Teplitxky et al. (U.S. Patent Pub. No. 2005/0162277; hereinafter “Teplitxky”). Applicants respectfully traverse and request reconsideration.

As an initial matter, Applicants have amended claims 1, 8, and 10. Claims 1, 8, and 10 have been amended to include, for example, the subject matter of cancelled claim 2. Support for these amendments may be found, for example, in paragraphs [0081], [0092], and [0117] of the present disclosure.

Claim 2 has been cancelled without prejudice. Therefore, no further discussion on cancelled claim 2 will be provided.

Claims 1 and 10

Claims 1 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Deas. Because claim amended claims 1 and 10 now contain, *inter alia*, the limitations of cancelled claim 2, Applicants will discuss the rejections of claims 1 and 10 in the

context of the rejection of claim 2. Amended claims 1 and 10 require, *inter alia*, “a stored periodically changing media content list.” Applicants respectfully submit that neither Adams, Deas, Goff, or Fraier, either alone or in combination, teach at least this limitation.

With respect to the rejection of now-canceled claim 2, Goff has been cited as teaching memory containing a stored periodically changing media content list. (Office Action mailed 7/7/2010, p. 7). Specifically, the Office Action alleges that this limitation is taught by paragraph [0040] of Goff. Applicants have reproduced this portion of Goff below:

[0040] One example of information which could improve the performance of a library identification system if present on the RFID tag itself would be a library identification number. Then, without accessing a database, an item's "home" library could be quickly and conveniently determined by simply scanning the RFID label. Another example of information preferably present on an RFID tag itself would be a code designating whether the item was a book, a video tape, an audio tape, a CD, or some other item. This code could, for example, comprise the media type code specified in the 3M Standard Interchange Protocol, which is available from the assignee of the present invention. By immediately knowing the media type, a library's material management systems could insure that an item was being appropriately processed without incurring the delay and inconvenience of consulting a remote circulation database. Other examples of information suitable for incorporation into the RFID label will be apparent to those skilled in the art.

Thus, the cited portion of Goff discloses storing identification information on an RFID tag. The identification information could, for example, identify the home library of an item that the RFID tag is attached to, or designate whether the item is a book, video tape, CD, etc. However, the cited portion of Goff fails to disclose a stored *periodically changing media content list*.

Conversely, the present disclosure teaches, and claims 1 and 10 require, “a stored periodically changing media content list.” For example, the present disclosure states that, “the media content providing device, such as DRM service provider 36 may also include memory . . . that stores the periodically changing media content list.” (Present Disclosure, ¶ [0117]). The stored periodically changing media content list specifies which particular media

is available for download at a given time from a varying library of media. For example, the present disclosure contemplates using the stored periodically changing media content list to provide users with, for example, access to the top 10 current songs, movies, etc. (Present Disclosure, ¶ [0114]: “In this example, the [stored periodically changing media content] list is the contents/media mapping table . . . [t]o effect a Top 10 list based dynamic content feature, a predetermined number of media elements, such as the Top 10, vary as set forth in the contents/media mapping table . . .”). This concept is elaborated on in paragraph [0119] of the present disclosure, which provides: “The periodically changing media content list includes data representing for example, one of a predetermined number of variable downloadable movies, a predetermined number . . . of variable downloadable songs and a predetermined number of variable downloadable music albums, or any other suitable downloadable media.” (Present Disclosure, ¶ [0119]). Thus, the present disclosure teaches, embodied in the recitations of claims 1 and 10, a stored periodically changing media content list. Because none of the cited references, either alone or in combination, teach at least this limitation, Applicants respectfully submit that claims 1 and 10 are in condition for allowance.

Claim 8

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Deas in further view of Goff and in further view of Fraier. Applicants note that claim 8, although different in scope, includes the limitation discussed above with respect to claims 1 and 10, i.e., “a stored periodically changing media content list.” To the extent that Fraier fails to overcome the shortcomings of Adams in view of Deas and Goff noted above, Applicants submit that claim 8 is allowable over Adams in view of Deas in further view of Goff and in further view of Fraier for at least the reasons given above relative to claims 1 and 10.

Claims 3–5, 7, and 11–14

Claims 3–5, 7, and 11–14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Deas in further view of Fraier. Applicants note that claims 3–5, 7, and 11–14, are dependent upon, and therefore incorporate the limitations of, independent claims 1 and 10, respectively. To the extent that the combination of Adams in view of Deas and in further view of Fraier fails to overcome the shortcomings noted above relative to claims 1 and 10, and because they recite additional patentable subject matter, Applicants respectfully submit that claims 3-5, 7 and 11-14 are in suitable condition for allowance.

Claim 6

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Deas in further view of Goff. Applicants submit that claim 6, being dependent upon claim 1, is also allowable over Adams in view Deas in further view of Goff to the extent that it incorporates the limitations of claim 1 and because it recites additional patentable subject matter.

Claim 9

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Deas in further view of Goff and Fraier and in further view of Teplitxky. Applicants note that claim 9 is dependent upon, and therefore incorporates the limitations of, independent claim 8. To the extent that the combination of Adams in view of Deas, Goff and Fraier and in further view of Teplitxky fails to overcome the shortcomings noted above relative to claim 8, and because it recites additional patentable subject matter, Applicants respectfully submit that claim 9 is in suitable condition for allowance.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request reconsideration and withdrawal of all presently outstanding rejections. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned at the number below.

Date: September 21, 2010

Vedder Price P.C.
222 N. LaSalle St., Suite 2600
Chicago, Illinois 60601
phone: (312) 609-7842
fax: (312) 609-5005

Respectfully submitted,
/Christopher P. Moreno/

By: _____
Christopher P. Moreno
Registration No. 38,566